

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 15026US02

PATENT

In the Application of:

Jeyhan Karaoguz, et al.

Serial No.: 10/672,864

Filed: September 26, 2003

For: REMOTE MANAGEMENT OF TV
VIEWING OPTIONS IN A MEDIA
EXCHANGE NETWORK

Examiner: Wang, Liang Che

Group Art Unit: 2153

Confirmation No.: 1276

Electronically Filed On April 23, 2008

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: April 23, 2008

By: /Joseph M. Butscher/
Joseph M. Butscher
Reg. No. 48,326
Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100

REMARKS

The present application includes pending claims 1-68, all of which remain rejected.

Initially, the Applicants note that the Examiner initialed the wrong information disclosure statement. *See* February 29, 2008 Office Action. The Applicants requested that the Examiner consider and initial the Information Disclosure Statement that the Applicants filed **with respect to the present application** on January 25, 2008. *See* March 13, 2008 Response at 17. The Examiner still has not done so. Thus, the Applicants respectfully request that the Panel instruct the Examiner to do so.

The Applicants respectfully submit that the proposed combination of Lu and Billmaier does not render claims 1-7, 9, 12-19, 21, 24, 37-42, 44-51, 53, 56-63, 65 and 68 unpatentable. *See id.* at pages 17-21. The Examiner has failed to establish a *prima facie* case of obviousness with respect to these claims. *See id.* The only portion of Lu that the Examiner cites as disclosing maintaining a “user defined association of the first and second network addresses” does not describe, teach or suggest such limitation. *See id.* at pages 19-20. Additionally, the only portion of Lu that the Examiner cites as disclosing “respond[ing to a request that identifies one of the associated first and second protocol addresses] by identifying the other of the associated first and second network address” does not describe, teach or suggest this limitation. *See id.* at pages 20-21.

Neither Lu, nor Billmaier describes, teaches, or suggests “server software that maintains a **user defined** association of the first and second network addresses [**with respect to first and second users, respectively, at first and second homes, respectively, wherein the second user is known to the first user**], receives, via a communication network, a request that identifies one

or more of the associated first or second network addresses, a user identifier, and authorization information, and **responds by identifying the other of the associated first or second network addresses...**,” as recited in claim 1. Independent claims 13, 37, 45 and 57 recite similar limitations. Moreover, the Examiner has cited nothing from the references that describes, teaches or suggests these limitations. *See id.* at pages 17-21. Thus, for at least these reasons, the Office Action has not established a *prima facie* case of obviousness with respect to the pending claims.

For at least the reasons noted above, the Examiner has also failed to establish a *prima facie* case of obviousness with respect to claims 8, 20, 43, 52 and 64. *See id.* at page 21.

Next, the proposed combination of Lu, Billmaier and Pocock does not render claims 10, 11, 22, 23, 25-32, 34-36, 54, 55, 66 and 67 unpatentable. *See id.* at pages 21-25. Once again, the Applicant has demonstrated that the portions of the cited references that the Examiner relies on do not describe, teach or suggest the relevant limitations. *See id.* at pages 22-23. In particular, the portions of Pocock relied on by the Examiner do not describe, teach or suggest “server software that receives from the telephone voice response system a request, and responds by enabling the management of the associated set of options governing the consumption of media.” *See id.* Thus, for at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness with respect to these claims.

For at least the reasons noted above, the Examiner has also failed to establish a *prima facie* case of obviousness with respect to claim 33. *See id.* at page 25.

The Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness with respect to any of the pending claims for at least the reasons discussed

Appln. No. 10/672,864
Pre Appeal Brief Request for Review
April 23, 2008

above and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees, including the \$510 fee for the Notice of Appeal, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: April 23, 2008

MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100

/Joseph M. Butscher/
Joseph M. Butscher
Registration No. 48,326
Attorney for Applicants